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APPLICATION NO.	FI	ILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
10/713,898	10/18/2002		David C. Schwartz	960296.99047	4216
27114	7590	06/14/2006		EXAMINER	
QUARLES			MUMMERT, STEPHANIE KANE		
411 E. WISCONSIN AVENUE, SUITE 2040 MILWAUKEE, WI 53202-4497			40	ART UNIT	PAPER NUMBER
	- <b>-</b> ,			1637	

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No. Applicant(s)						
	10/713,898	SCHWARTZ ET AL.					
Office Action Summary	Examiner	Art Unit					
	Stephanie K. Mummert	1637					
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply							
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA  - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication.  - If NO period for reply is specified above, the maximum statutory period w  - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 6(a). In no event, however, may a reply be timil apply and will expire SIX (6) MONTHS from cause the application to become ABANDONEI	l.  lely filed  the mailing date of this communication.  O (35 U.S.C. § 133).					
Status							
1) Responsive to communication(s) filed on							
·- · · · · · · · · · · · · · · · · · ·	- action is non-final.						
3) Since this application is in condition for allowan	ce except for formal matters, pro	secution as to the merits is					
closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.							
Disposition of Claims							
4)⊠ Claim(s) <u>1-33</u> is/are pending in the application.							
4a) Of the above claim(s) is/are withdraw	4a) Of the above claim(s) is/are withdrawn from consideration.						
5) Claim(s) is/are allowed.							
6) Claim(s) is/are rejected.							
7) Claim(s) is/are objected to.							
8) Claim(s) <u>1-33</u> are subject to restriction and/or e	election requirement.						
Application Papers							
9)☐ The specification is objected to by the Examiner	•						
10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.							
Applicant may not request that any objection to the o	lrawing(s) be held in abeyance. See	37 CFR 1.85(a).					
Replacement drawing sheet(s) including the correcti	, , , ,	* *					
11) The oath or declaration is objected to by the Ex	aminer. Note the attached Office	Action or form PTO-152.					
Priority under 35 U.S.C. § 119							
<ul> <li>12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</li> <li>a) All b) Some * c) None of:</li> <li>1. Certified copies of the priority documents have been received.</li> <li>2. Certified copies of the priority documents have been received in Application No</li> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> <li>* See the attached detailed Office action for a list of the certified copies not received.</li> </ul>							
Attachment(s)  1) Notice of References Cited (PTO-892)  2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  Paper No(s)/Mail Date	4)  lnterview Summary Paper No(s)/Mail Da	(PTO-413)					

## **DETAILED ACTION**

## Election/Restrictions

- 1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - Claims 1-20 and 33, drawn to an apparatus for fixing and straightening polymeric molecules, classified in class 422, subclass 99.
  - II. Claims 21-27, drawn to a method of fixing and straightening polymeric molecules, classified in class 435, subclass 6.
  - III. Claims 28-32, drawn to a method of manufacturing a micro-channel for straightening and fixing polymeric molecules, classified in class 422, subclass 58.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used in many different materially different processes, including sequencing, size separation, HPLC, or affinity separation techniques. Due to the many different processes for which the apparatus of Group I may be useful, in order to fully search the invention of groups I and II would require a separate and distinct search of each group. In order to search the apparatus of group I would require a search that is separate and distinct from the method of fixing and straightening polymers of Group II. Therefore, because a separate search of the apparatus, independent of the

intended use in straightening and fixing polymers, it would pose an undue burden on the examiner to require a search of these inventions together.

- 3. Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are directed to separate and distinct classes of invention that are not disclosed as capable of use together. While the apparatus of group I comprises a microchannel, the method of group III is not a method of making the apparatus of group I. Therefore, a search of the method of group III would require a search of the steps required to form a microchannel, but would not necessarily address the apparatus of group I. In the reverse, a search of the apparatus of group I would not necessarily address the formation of the microchannel component of the array with the same method steps as described in the method of group III. Therefore, because a full search of each of these groups would not be coextensive in search terms or in scope, it would pose an undue burden on the examiner to require a search of the method of group III and the apparatus of group I together.
- 4. Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different groups of inventions are directed to separate and distinct methods which have different modes of operation, different method steps and result in different outcomes. The method of group II is directed to a method of fixing and straightening polymeric molecules, while the method of group III is directed to a method of manufacturing a

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micro-channel. A prior art search of the method of group II would not encompass search terms directed to the manufacture of the microchannel, as described in the method of group III. At the same time, a search of the method of group III would not encompass search terms directed to the method of polymer fixing and straightening of group II. Therefore, because the searches of these separate inventions are not co-extensive, and would require separate text searches of the prior art, it would pose an undue burden on the examiner to examine these inventions together.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected 5. invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one Art Unit: 1637

or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephanie K. Mummert whose telephone number is 571-272-8503. The examiner can normally be reached on M-F, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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